

Remarks/Arguments

Claims 1-59, and 64-67 are pending in this application. Claims 60-63 are withdrawn from consideration, as deemed drawn to an unelected species.

Amendments

Claims 48, 49, and 53 are currently amended. These amendments do not add new matter because they are supported by a number of statements in the specification; for example see page 21, lines 10-17. Claim 33 is also amended to fix a typographical error.

Claim Rejections – 35 USC §112

Applicant appreciates the Office Action's pointing out the improper use of the definite article in claim 33. This claim has been amended to comply with grammatical conventions.

Double Patenting

Office Action correctly notes that "[w]hen two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other." However, the Office Action warns that "should any of the independent claims be found allowable, the remaining independent claims within the same statutory class will be objected to under 37 CFR § 1.75 as being a substantial duplicate thereof." (emphasis added.)

The direct implication of this statement is that *every* independent claim in the current application in the same statutory class covers the same thing. The following example shows this is incorrect. Consider claims 1 and 20 which are both drawn to methods. Claim 1 recites "a content provider computer system, a central computer system, and a client computer system." Claim 20, however, recites "at least two computer systems" including "a first computer system"

and “a second computer system.” Because claim 1 recites three computer systems while claim 20 recites only 20, the two claims do not cover the same thing, yet are within the same statutory class. This counterexample rebuts the statement in the Office Action. If some but not all claims in each statutory class are believed to be identical, Applicant would appreciate a specific enumeration of these claims.

Claim Rejections – 35 USC §103

Claims 1-59 and 64-67 are rejected under 35 U.S. C. 103(a) as being unpatentable over US Patent No. 6,581,065 to Rodkin (hereinafter referred to as “Rodkin”) in view of U.S. Patent No. 5,822,539 to van Hoff (hereinafter referred to as “van Hoff”).

A. Neither Rodkin nor van Hoff embed or transfer code executable by the client.

Claims 1, 29-31, 44, 45, 54, 64, and 66 recite embedding or transferring code executable by the client. Rodkin shows a self-styled “Intelligent Annotator™” computer program which runs on a server and embeds hyperlinks into a document available to a browser. Van Hoff shows a proxy server which merges hypertext links into a document while in transit between a web server and a browser. The Office Action asserts that Rodkin teaches “in an electronic content document retrievable from a content provider computer system storing content documents, embedding code executable by a client computer.” While both references show insertion of hyperlinks, neither teaches nor suggests embedding or transferring *code executable by the client*, which is a prerequisite to the recited features of recognition and recognition. Accordingly, the insertion of such code cannot be the same as insertion of hyperlinks because that would fall under the annotation function recited later in the claim. If the Action is attempting to assert it is the same, then those later steps of recognition and annotation would either be rendered meaningless, which cannot be the case, or not disclosed in the cited references. Consequently, a prima facie case has not been made, as explained in more detail below.

Rodkin recites that a "content server 410 processes an on-line text article 405 to automatically associate hypertext anchor codes with various character strings." Col. 12, lines 39-42. Rodkin teaches that the Web surfer's browser interacts passively without executing code; the "browser 435 communicates with the content server 410," "[t]he Web surfer clicks on ... hypertext," and "the Web surfer's browser 435 then communicates with a third party server 445." Col. 13, lines 11-19. While Rodkin embeds hyperlinks into an electronic content document, these hyperlinks are not considered by persons skilled in the art to be "code executable by a client computer." Thus, Rodkin does not teach or suggest embedding or transferring code executable by a client computer.

Nor does Van Hoff teach or suggest embedding or transferring code executable on a client computer. Van Hoff shows an annotation proxy server that inserts hyperlinks into a document. "If the character pattern is found in a requested document, that indicates that an annotation linking the portion of the document associated with the matching pattern to the paired cross reference source should be added to the requested document." Col. 5, lines 41-45. For example, van Hoff discloses that the text string "Java!" may be replaced with a hyperlink to "sun.com.java.info." Col. 5, lines 45-50; see also Figs. 3-5. As in Rodkin, van Hoff merely inserts hyperlinks into the document, not "code executable by a client computer." Therefore, van Hoff does not teach or suggest embedding or transferring code executable on a client computer.

The failure of both cited references to embed or transfer code executable by the client provides at least one reason to distinguish claims 1, 29-31, 44, 45, 54, 64, and 66. Claims 1 and 64 both recite "embedding code executable by a client computer." Claim 29 recites that "the electronic document includes code executable by the second computer system." Claim 30 recites "a code executable by the first computer system is embedded in the web page." Claim 31 recites "sending annotation instructions to the first computer system." Claim 44 recites a data object for sending to the computer system "wherein the data object comprises computer code executable by the second computer system." Claims 45 and 66 both recite "transmitting to a

consumer computer system a consumer code executable on the consumer computer system.”

Claim 54 recites a “web document containing code executable by a client computer system.”

For at least the foregoing reasons, a prima facie obviousness case for claims 1, 29-31, 44, 45, 54, 64, and 66 has not been made.

B. Neither Rodkin nor van Hoff transmits recognition or annotation instructions or information.

Claims 1, 6, 13, 20, 22, 27, 33, 34, 52, 54, 65, and 67 recite transmission or recognition of annotation instructions or information. However, even assuming merely for the sake of argument that Rodkin or van Hoff incorporate annotation or recognition information or instructions, they do not *transmit* annotation or recognition information or instructions.

The Office Action alleges that Column 14, Lines 45-51 show generating annotation instructions. This portion recites content server administrator input 530 which may “allow a person to select particular words in an article which are to be linked.” As Figure 5 shows, however, the content server administrator input 530 is provided directly to the content server and is not transmitted from one computer system to another.

Van Hoff teaches an annotation proxy server 118 which includes one or more cross reference directories 124. Even assuming for the same of argument that these cross reference directories include recognition or annotation information or instructions, there is no teaching or suggestion that the cross reference directories are ever *transmitted*. Accordingly, this is another independent reason why claims 1, 6, 13, 20, 22, 27, 33, 34, 52, 54, 65, and 67 are nonobvious.

Looking at the specific language of the claims, the recitation of this functionality is express. Claim 1 recites “sending the [annotation] instructions to the client computer system.” Claim 6 recites “key element data being sent to the remote computer by the client computer system.” Claim 13 recites that the “user’s selection of an annotation key element data is sent to a remote computer system.” Claim 20 recites “sending annotation instructions.” Claim 22 recites

"sending a key list from a remote computer system to a client computer system ... the key list being adapted for the client computer to use in performing ... one or more of (i) recognizing key elements and (ii) annotating key elements." Claim 27 recites "sending instructions to the first computer system." Claim 33 recites "from a first computer system, providing a second computer system a set of predetermined key elements and corresponding identifiers for use in creating annotations." Claim 34 recites "key element data being transferred over a packet-switched network to another computer system." Claim 52 recites "code is adapted to retrieve a key list from a remote computer system." Claim 54 recites "annotation instructions that are returned to the client computer system." Claim 65 recites "sending instructions to the consumer computer system for presenting to the user of the consumer computer system one or more hyperlinks." Finally, claim 67 recites "code ... invokable on the central computer system by a client computer system to generate annotation instructions for the client computer system." For at least the foregoing reasons, the prima facie case for claims 1, 6, 13, 20, 22, 27, 33, 34, 52, 54, 65, and 67 has not been made.

C. Exchanging the client computer and content computer is not a simple substitution.

The Office Action asserts that claims 2-4, 30-32, and 57-58 are obvious because exchanging the client computer and the content computer is a "simple substitution" based on "known structural elements in the art." This is a factual assertion about the equivalency of two electronic components based on the state of knowledge in the art. However, the Office Action presents no evidence in support of this factual assertion, nor is this plainly the case. Official notice of facts beyond the record is permitted only where these assertions are "capable of such instant and unquestionable demonstration as to defy dispute." MPEP 2144.03(A); *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961). As such, reliance on this factual assertion for rejection

lacks the necessary evidentiary basis and is, therefore, improper. Applicant requests that evidence be provided in support of this factual assertion.

In the interest of advancing prosecution, the following rebuttal argument is provided in advance. The asserted equivalency of the "content computer" and the "client computer," is disputable for at least three reasons which follow.

First, the "content computer" and "client computer" most likely have very different hardware and software. The "content computer" most likely would use a server operating systems such as BSD, Linux, or Windows Server 2003 while the "client computer" would most likely use a home operating system such as Windows XP. In addition, the computing hardware for a server such as redundant power supplies, RAID disk arrays, and a large amount of ECC memory substantially differs from the computing hardware for a home computer such as non-ECC memory and a single disk drive. Because of these differences, a software program written to run on a server would be substantially different from a software program written to run on a home computer. Further, server applications are usually built from source using makefiles or with custom application deployment procedures, while software distributed for home computers uses an installer package. These typical differences are highly relevant to the design and implementation of the system claimed. For example, one component of one embodiment of the invention might be a software program designed to run on a particular operating system such as GNU/Linux. This program would not run on any other operating system such as Windows XP. Although there are "write once, run everywhere" technologies such Java, their performance is often an order of magnitude slower than the same program written in a more basic language such as C.

Second, the manner of practicing the invention varies radically, depending on who is practicing the invention. A content provider who has control over the "content computer" has the power to determine which operating system and hardware runs on the machine and have low level access to the machine, however, has only access to the browser on the "client computer"

which is controlled by users. One embodiment might include a computer program written in the C programming language targeting Linux and intended to use a relational database such as MySQL with a large amount of free storage to run on the "content computer." The same program if intended to run in the browser on the "client computer" would have to be written for the browser environment in Javascript or an installed plug-in such as Adobe Flash. In addition, a relational database is almost always available on server but virtually never available on a home computer. Even the presence of *any* persistent disk storage on a home computer is questionable. Similar considerations are present from the perspective of another party such as an ISP or the user. In any case, the design and implementation of the components would be radically different because of the natural distribution of control and heterogeneity of computer networks such as the internet.

Third, the asymmetric nature of computer network connections means that from any participant's perspective, the remote computing environment changes while the local environment stays the same. For example, a web site owner may have contacts from a variety of different browsers including three versions of Internet Explorer, two variants of Firefox, Safari, and Opera no single version with more than 30% market share. See, e.g., http://www.w3schools.com/browsers/browsers_stats.asp. This makes targeting a specific browser impractical, so applications to run on the client must use a "lowest common denominator" while applications run locally can make any assumptions they need because the server environment is build-to-order. Conversely, a user can install whatever software and hardware they want on their home machine, but there is significant variety in web servers. See, e.g., <http://news.netcraft.com/>. This means programs running locally can make assumptions and perform configuration while remote computer requirements are "lowest common denominator."

For at least these reasons, the "client computer" and the "content computer" are not interchangeable. Without this factual assertion, the predicated rejection in the Office Action of

claims 2-4, 30-32, and 57-58 will not stand, precluding a prima facie case of obviousness.

Claims 2-4, 30-32, and 57-58 are, therefore, allowable for at least these reasons.

D. The Office Action makes no showing of the role of the Internet service provider.

Claims 4, 32, and 58 recite a specific role for the Internet service provider. The Office Action does not identify limitations related to the Internet service provider. As such, a prima facie case of obviousness has not been made for claims directed to such limitations. In addition, neither Rodkin nor van Hoff teaches or suggests limitations related to the Internet service provider.

Rodkin is oblivious to the existence of the Internet service provider and even teaches away from a specialized role for the Internet provider by emphasizing that the invention is agnostic about intervening network architecture between the content server and the client. Rodkin works "with virtually any computer network, including intranets, local area networks, and wide area networks." Col 24, lines 52-53. This teaching suggests that such an agnostic design is desirable, which teaches away from specialized roles based on their position in the network.

Similarly van Hoff fails to mention the Internet service provider at all. In fact, van Hoff distinguishes an annotation proxy server 118 on the same hardware platform as the user's Web browser 110 from a remote annotation proxy server 119 located on "another linked computer." Col 4, lines 22-27. Van Hoff, like Rodkin contemplates a network agnostic design which deemphasizes the role of the Internet service provider.

Because claims 4, 32, and 58 include limitations specifically related to the Internet service provider, these claims are not obvious. Looking at the specific language of the claims, the express recitation of an Internet service provider is clearly seen. Claim 4 recites that "the code embedded into the content document is embedded by a party controlling a computer system associated with the Internet service provider for the client computer system." Claim 32 recites that "code is embedded in the electronic document by a computer system of an Internet

service provider.” Claim 58 recites that “the server is controlled by the party controlling the Internet service provider that serves as a conduit for delivery of the web document to the client computer system.” The Office Action makes no argument that these limitations are present, nor does either reference show an awareness of a special role for the Internet service provider. Accordingly, the prima facie case of obviousness of claims 4, 32, and 58 has not been made and these claims are allowable.

E. Neither Rodkin nor van Hoff shows a query for use by a search engine.

Claim 5 recites that “the annotation for a key element is associated with data (“key element data”) that is suitable for forming a query for use by a search engine to locate information related to the key element.” The Office Action points to Rodkin’s disclosure of hyperlinking the Dow Jones industrial average.

Rodkin discloses a “hypertext ‘quote’ which is associated with the character string ‘Dow Jones industrial average’” Col 16, lines 21-23. Rodkin also discloses a “home page which might provide the user with general information regarding the Dow Jones industrial average.” Col 16, lines 16-18. Neither, however, is a query for use by a search engine. Rodkin does not disclose the use of information suitable for forming a query for use by a search engine. Nor does van Hoff. Without this limitation, the prima facie case for obviousness for claim 5 has not been made.

F. Neither Rodkin nor van Hoff teaches annotation of information about products.

Claims 7 and 35-38 each have product related limitations. The Office Action alleges that Rodkin teaches finding information about products by disclosing a hyperlink for the “Dow Jones industrial average.” The specification distinguishes between products and services, specifically providing “[e]xamples of products or services ... consumer products, cars, vacations, movies,

music, financial and information services.” Page 9, line 21 – page 10, line 1. Note that the claims are drawn only to products.

Read in light of the language of the specification, the Dow Jones industrial average is a “financial service” as disclosed above. However, only products are claimed. Because the cited evidence relates to a service not a product, it does not read on the “product” limitation in the claims.

Because the cited art does not cover product information, the prima facie case for claims 7 and 35-38 has not been made. Claim 7 recites a search “adapted to find information about products relating to the key element.” Claim 35 recites, in part, that “the information relates to products.” Additionally, claim 36 recites, in part, “sending product-related information.” Claim 37 recites, in part, that “product-related information includes products listed by category.” Finally, claim 38 recites, in part, that “product-related information includes comparative product information.” For at least the reason the prima facie case for obviousness of claims 7 and 35-38 has not been made.

Nothing herein should be deemed as a disclaimer or surrender of any rights, an acquiescence in any rejection, or a waiver of any arguments that might have been raised but were not raised herein or otherwise in the prosecution of this application. Applicant reserves all rights and subject matter with respect to claims being or to be pursued in this or a related application.

CONCLUSION

Applicant submits that in view of the foregoing remarks and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested.

The Commissioner is hereby authorized to charge any fees, including extension fees, or to charge any additional fees or underpayments, including extra claim fees, or to credit any overpayments, to the Credit Card account referenced and authorized via the EFS Web

(Electronic Filing System). As an alternative, in case the Credit Card cannot be processed, the Commissioner is hereby authorized to charge any fees, additional fees, or underpayments, or to credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

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